UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/974,624	10/09/2001	Alfred T. Tabayoyon JR.	SWIF 2123	8468

7812   7590   07/25/2006

SMITH-HILL AND BEDELL, P.C.
16100 NW CORNELL ROAD, SUITE 220
BEAVERTON, OR 97006

EXAMINER
AVELLINO, JOSEPH E

ART UNIT	PAPER NUMBER
2143	

DATE MAILED: 07/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

UNITED STATES PATENT AND TRADEMARK OFFICE

MAILED

JUL 2 5 2006

Technology Center 2100

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 09/974,624
Filing Date: October 09, 2001
Appellant(s): TABAYOYON ET AL.

Daniel J. Bedell
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed May 22, 2006 appealing from the Office

action mailed February 24, 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,789,105	McMillan et al.	9-2004

6,360,254   Linden   3-2002

6,266,703   Clark et al.   6-2001

6,209,030   Ohashi   3-2001

6,237,099   Kurokawa   5-2001

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

1.   Claims 1, 2, 4-8, 13-17, and 21 are rejected under 35 U.S.C. 103(a) as being

unpatentable over McMillan (USPN 6,789,108) in view of Linden et al. (USPN

6,360,254) (hereinafter Linden) in view of Clark et al. (USPN 6,266,703) (hereinafter

Clark).

2.   Referring to claim 1, McMillan discloses a method for transmitting a document file

describing a document from a sender computer 25 to a receiver computer 25 via a

computer network 16 linking the sender computer and the receiver computer to a server

computer 12-15, wherein the sender computer is operated by a sender, wherein the

receiver computer is operated by a receiver, the method comprising the steps of:

     a.   generating a document file describing the document on the sender

     computer (i.e. content file or the like) (col. 7, lines 60-67);

     b.   transmitting the document file from the sender computer to the server

     computer via the computer network (Figure 10, 321; col. 8, lines 3-16);

c.   transmitting the document file (i.e. email) from the server computer to the

receiver computer via the computer network (Figure 11, 330; col. 8, lines 17-48);

d.   providing viewer software (col. 3, lines 45-60; col. 4, lines 55-59) executed

by the receiver computer for generating a display of an image of the document

(i.e. flash file or the like) described by the document file (i.e. email) when

received by the receiver computer (col. 7, line 58 to col. 8, line 2), and for

thereafter returning verification data to the server computer via the computer

network verifying that the receiver computer has successfully displayed the

document image (Figure 12, 340; col. 8, line 49 to col. 9, line 52).

McMillan does not explicitly state that the email contains a hypertext link that the

receiver activates to send a reference to the document file to the server computer, and

the server computer sending the document file to the receiver computer to display the

document. In analogous art, Linden discloses another method of transmitting a

document file describing a document from a sender computer to a receiver computer

which discloses embedding a hyperlink 74 in an email 72 for the receiver 32 to request

a document file (i.e. GET URL) 76, and the server computer supplying the document to

the receiver computer 78 (Figure 2). It would have been obvious to one of ordinary skill

in the art to combine the teaching of Linden with McMillan in order to provide a more

secure method of email viewing (i.e. disallowing executable programs to launch

automatically upon opening an email), which will reduce the likelihood of virus infection

or unwanted executing of scripts.

McMillan in view of Linden does not specifically disclose that the receiver computer automatically returns verification data to the server computer. In analogous art, Clark discloses another method for transmitting a document file (i.e. pictorial representation of three isochronous documents) which discloses automatically returning verification data to the server computer that the receiver computer has successfully displayed the document image (col. 7, lines 5-25). It would have been obvious to one of ordinary skill in the art to combine the teaching of Clark with McMillan and Linden in order to ensure that the users of McMillan were able to view the documents, instead of not viewing the advertisement embedded in the email, thereby making sure that the user accesses objects requested by an originator as supported by Clark (e.g. abstract; col. 1, lines 60-65).

3.   Referring to claim 2, McMillan discloses further comprising the steps of:

e.   storing log data (i.e. tracking software) on the server computer indicating when the receiver computer returned the verification data to the server computer (Figure 13, 410; col. 9, line 15-52); and

f.   providing the sender computer with access to the log data via the computer network (col. 10, lines 38-54).

4.   Referring to claim 4, McMillan discloses further comprising the steps of:

d.   transmitting a publish request from the sender computer to the server

computer wherein the publish request identifies the receiver computer (col. 8,

lines 3-16); and

e.   prior to step b, transmitting an email message generated by the sender

from the server computer to the receiver computer identified in the publish

request, wherein the email message references the document file (col. 8, lines 3-

16).

5.   Referring to claim 5, McMillan discloses further comprising the steps of:

g.   prior to step e, storing the document file in the server computer and

assigning a network address to the document file stored on the server computer

(it is an inherent feature that whenever a file is stored onto a computer, it is

assigned a unique file address, otherwise there will be no way in accessing the

file) (col. 7, lines 3-27), wherein the email message transmitted at step e includes

a reference to the assigned network address (col. 7, lines 59-67).

6.   Referring to claim 6, McMillan discloses the reference to the assigned network

address is a hypertext link included in the email message (i.e. a standard email

message) (col. 7, lines 59-67).

7.   Claim 7 is rejected for similar reasons as stated above.

8.   Referring to claim 8, McMillan discloses wherein step b comprises the sub-steps

of:

   b1.   verifying that the receiver is signed on to the server computer (i.e.

   password and username to the email account (Figure 13, 410; col. 9, lines 15-53,

   parameters i and j); and

   b2.   thereafter transmitting the document file from the server computer to the

   receiver computer via the computer network (col. 8, lines 17-48).

9.   Referring to claim 13, McMillan discloses the receiver computer returns the

verification data to the server computer as an encoded network address (col. 9, lines

15-52).

10.   Claims 14-17, and 21 are rejected for similar reasons as stated above.

       Claims 9, 10, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable

over McMillan-Linden-Clark in view of Ohashi (USPN 6,209,030).

11.   Referring to claim 9, McMillan-Linden-Clark discloses the invention substantively

as described in claim 1. McMillan-Linden-Clark further discloses transmitting a publish

request from the sender computer to the server computer, wherein the publish request

identifies the receiver computer, and transmitting the document file from the sender

computer to the server computer via the computer network (see claims above).

McMillan-Linden-Clark does not specifically disclose the publish request indicated that the receiver computer is to be prevented form printing the document file. In analogous art, Ohashi discloses another method of transmitting document files from a sender to a receiver wherein the publish request (i.e. tag information) is that the receiver computer is to be prevented from printing the document file (e.g. abstract). It would be obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Ohashi with McMillan-Linden-Clark since McMillan discloses that other encapsulation packages can be used (wherein the term "encapsulation" is taken as bundling the information for distribution in various entities) (col. 4, lines 45-48). This would lead one of ordinary skill in the art to search for other encapsulation means which would lead one to Ohashi and a secure encapsulation of HTML files such that hard copying of files is denied, thereby reducing the tendencies of unauthorized users obtaining classified or internal information as supported by Ohashi (col. 2, lines 10-18).

12.   Referring to claim 10, McMillan-Linden-Clark discloses the invention substantively as described in claim 9. McMillan-Linden-Clark further discloses transmitting the document file from the server computer to the receiver computer via the computer network (see claim rejections above). McMillan-Linden-Clark does not specifically disclose preventing the receiver computer from printing the document file. In analogous art, Ohashi discloses another method of transmitting document files from a sender to a receiver which prevents the receiver computer from printing the document file (e.g. abstract). It would be obvious to a person of ordinary skill in the art at the time

the invention was made to combine the teaching of Ohashi with McMillan and Wang

since McMillan discloses that other encapsulation packages can be used (col. 4, lines

45-48). This would lead one of ordinary skill in the art to search for other encapsulation

means which would lead one to Ohashi and a secure encapsulation of HTML files such

that hard copying of files is denied, thereby reducing the tendencies of unauthorized

users obtaining classified or internal information as supported by Ohashi (col. 2, lines

10-18).

13.   Claim 20 is rejected for similar reasons as stated above.

        Claims 11, 12, 18, and 19 are rejected under 35 U.S.C. 103(a) as being

unpatentable over McMillan-Linden-Clark in view of Kurokawa (USPN 6,237,099).

14.   Referring to claim 11, McMillan-Linden-Clark discloses the invention

substantively as described in claim 1. McMillan-Linden-Clark does not specifically

disclose assigning a password to the document and transmitting the password to the

server computer. In analogous art, Kurokawa discloses another method of transmitting

document files from a sender to a receiver wherein the sender assigns a password to

the document and transmitting the password to the server computer (Figure 3, 52, 53;

col. 2, lines 15-23). It would be obvious to a person of ordinary skill in the art at the time

the invention was made to combine the teaching of Kurokawa with McMillan-Linden-

Clark in order to provide secure access to files and to prevent unauthorized access to documents, which is a well known security issue in computer networking.

15.   Referring to claim 12, McMillan-Linden-Clark discloses the invention substantively as described in claim 1. McMillan-Linden-Clark does not specifically disclose providing a document password entry form to the receiver computer, entering a second password into the form to the server computer, and transmitting the document file from the server to the receiver when the second password matches the first password. In analogous art, Kurokawa discloses another method of transmitting document files from a sender to a receiver providing a document password entry form to the receiver computer, entering a second password into the form to the server computer, and transmitting the document file from the server to the receiver when the second password matches the first password (Figure 8, 90-95; col. 6, lines 31-58). It would be obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Kurokawa with McMillan-Linden-Clark in order to provide secure access to files and to prevent unauthorized access to documents, which is a well known security issue in computer networking.

16.   Claims 18-19 are rejected for similar reasons as stated above.

Claims 3 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over McMillan-Linden-Clark in view of Day et al. (USPN 6,243,722) (hereinafter Day).

17.   Referring to claim 3, McMillan-Linden-Clark discloses the invention substantively as described in claim 1. McMillan-Linden-Clark does not specifically disclose transmitting a comment file containing comments generated by the receiver form the receiver computer to the server computer, storing the comment file on the server computer, and providing the sender computer with access to the comment file. In analogous art, Day discloses another method of transmitting document files from a sender to a receiver which transmits a comment file containing comments generated by the receiver form the receiver computer to the server computer, storing the comment file on the server computer, and providing the sender computer with access to the comment file (Figure 7, 150; Figure 8, 162; col. 8, line 5 to col. 9, line 24). It would be obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Day with McMillan-Linden-Clark in order to collectively develop and modify networked-based documents, thereby reducing production time and increasing feedback upon the document.

18.   Claim 22 is rejected for similar reasons as stated above.

(10) Response to Argument

Appellant's arguments found in the Brief have been fully considered but are not persuasive.

Appellant argues, in substance, that (1) the combination of McMillan, Clark, and

Linden would not teach step f: sending verification data from the receiver computer to

the server computer indicating that the receiver computer has successfully displayed

the image of the document in the browser window (Brief, page 7, last paragraph), (2)

Ohashi is merely directed to preventing a print screen operation, not the sending of a

document file to a printer as specified in claim 9 (Brief, page 9), and (3) the combination

of McMillan, Linden, Clark and Kurokawa does not teach step f of the claimed invention

(Brief, page 12).

As to point (1) Appellant is incorrect. Appellant's attention is directed to Clark,

col. 7, lines 43-50 where it is clearly stated that "the invention [of Clark] provides a

method...for notifying an originator of an isochronous transmission with the recipient

has accessed a particular object for a specified period of time. The mechanism...may

be triggered by detecting accesses resulting from any process...such as a file access

printing, *viewing*, or listening to an object" (emphasis added). This clearly shows that

Clark can send confirmation back to a sender that a recipient has viewed a document

(Clark: col. 5, line 67 to col. 6, line 16. The system of McMillan and Linden provide

hypertext links in email (see rejection above) and would be beneficial to utilize the

system of Clark with McMillan-Linden in order to ensure the senders of McMillan-Linden

that the recipients have actually viewed the documents, rather than glancing at the

email and not following the links to the documents. Furthermore the system of Clark

would benefit from the addition of McMillan-Linden by only requiring the insertion of

hyperlinks into the email rather than the entire document. This would reduce sending

times and reduce bandwidth consumption, thereby reducing congestion on the network.

Appellant provides one line of thinking as to what the combination of the references

would create, however one of ordinary skill in the art would easily be able to combine

the references in order to create the claimed invention as evidenced by the rejections

above and the rationale provided in this response to argument. By this rationale, the

rejection should be maintained.

As to point (2) Appellant is incorrect. Appellant's attention is directed to col. 5,

lines 35-45 of Ohashi where it is stated that "if it is determined that an instruction to

make a hard copy has been issued, then it is determined whether or not tag information

indicating the prevention of a copy is included. If a copy is to be prevented, the process

immediately terminates". The "tag information" is information contained in the HTML

document (Figure 4; col. 4, lines 43-67). One of ordinary skill in the art would

understand the statement "instruction to make a hard copy" as a "print" instruction, (for

example clicking on the "print" icon in a browser), not necessarily a "print screen"

instruction as Appellant has attributed it to mean. Appellant points to col. 2, lines 10-18

of Ohashi as teaching the prevention of carrying out a print screen operation, however

this passage actually states "the user can easily make a hard copy of the information

displayed by the browser". This does not disclose a "print screen operation" as

Appellant has stated. One of ordinary skill in the art would clearly see this as a print

operation of the entire file, since a print screen operation only grabs what is directly on the screen at the time (as Appellant has pointed out in the Brief, page 10). However, many times the document does not entirely fit on the screen (i.e. the use of scroll bars or "page down" buttons must be used. Users would want the entire document, not just what is shown on the screen. Furthermore, the tag information within the document indicates the copy prevention attributes, one of ordinary skill in the art that the system would prevent the document from being sent to the printer. By this rationale, the rejection should be maintained.

As to point (3), Appellant is advised to review the response to argument (1) where it is clearly stated how the combination of McMillan, Linden, and Clark teach step f. By this rationale, the rejection should be maintained.
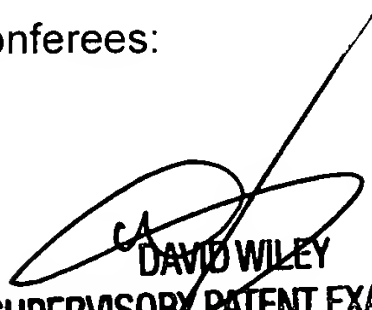
(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.
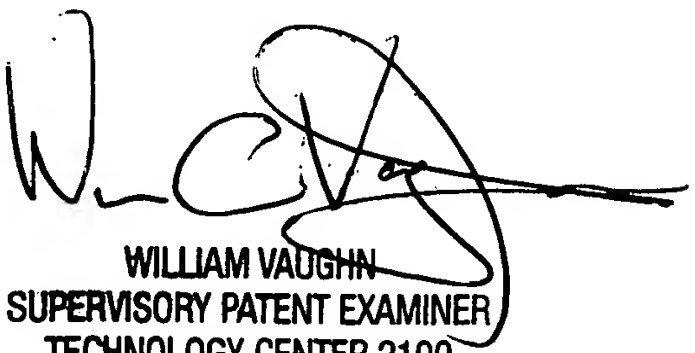
For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Joseph E. Avellino

Conferees:

DAVID WILEY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER

WILLIAM VAUGHN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100